IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Shuji SHICHI	Conf. 1070
Application No. 09/883,371	Group 3692
Filed June 19, 2001	Examiner Harish Dass

DATA SALE IMMEDIATE SETTLING METHOD
AND PREPAID CARD

REPLY BRIEF

MAY IT PLEASE YOUR HONORS:

This reply brief is in response to the Examiner's Answer of May 29, 2008 and supplemented on June 19, 2008.

Appellant is not in disagreement with Sections (1)-(8) and (11) of the Examiner's Answer (the "Answer"), and the Section (9) statement of the Grounds Of Rejection.

Appellant is in disagreement with the Examiner as to Section (10) Response to Argument.

I. In the paragraph spanning pages 14-15 of the Answer and the first full paragraph of Answer page 16, the Examiner states that a mere statement that a *prima facie* case of obviousness will not be considered substantially adequate to rebut the rejection.

Appellant has not merely alleged that a *prima facie* case of obviousness was not made, but has identified

shortcomings in the obviousness rejections such that the rejections cannot be maintained.

II. On Answer page 15, the Examiner asserts that appellant has argued features not recited in the claims, i.e., "As discussed above, the present invention provides a user-supplied "next-time" password as part of each card validation and set by the user prior to accessing the card's monetary balance. A user-set password is a password set by the user and not a password set by the system."

This is not accurate. Appeal Brief page 7 reads:

"See claim 16 step C)- sub-step iii) reciting the user entering another next-time password number and storing the user-input another next-time password in the database as the new, user-set next-time password number required for validation of the prepaid card in a next another action chain.

"Also see step B) sub-step iii) which is similar."

This is in contrast to the cited references which disclose that the site requests the user to change the password used for the first time access just after executing the first action (log-in).

The claims make clear that the claimed invention further requires repeating the user setting the next-time password each time the user executes the action (log-in) for the next time by using the next-time password changed from the

first time password, where it is the user that determines the password for the next-time.

This procedure works for both a human user and an automatic agent user.

When the user is a human, the user will change the password each time the human user executes the new action (log-in), and the new, user-set next-time password is stored in the database.

When the user is an automatic agent to which the control of communication or transaction with the site is consigned, the automatic agent will change the password each time the automatic agent executes the new action (log-in). For example, when the automatic agent logs into the site, the automatic agent will generate a new next-time password, e.g., with random numbers, and the new next-time password will be stored in the database as the new, user-set next-time password number required for validation of the prepaid card in a next another action chain.

III. The paragraph spanning Answer pages 16-17 relates to the "well known" actions that the Appeal Brief pointed out were not of record. The Examiner states that Appellant has not provided any evidence that these elements were unknown at the time of invention.

The Examiner has gotten the relative burdens of proof confused. The Examiner bears the initial burden of

presenting a *prima facie* case of obviousness. *In re Oetiker,*
977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met,
then the burden shifts to the Appellants to overcome the *prima
facie* case with argument and/or evidence. *(See Id.)* As to
these "well known" elements, it is the Examiner's burden to
show that they were indeed well known at the time of the
invention.

As stated in the paragraph spanning Appeal Brief
pages 8-9:

On pages 5-6 of the Official Action, there is a
paragraph that lists "well known" actions. That these are
well known <u>now</u> (i.e., in July 2007 when the Official Action
was mailed) is not evidence that these actions were known to
one skilled in the art <u>at the time of the invention</u>. It is
clear error to rely on facts not supported by the record. A
rejection including such clear error is improper.

The Examiner appears to say that the "well known"
elements are in the record "somewhere". If this is true, the
Examiner should point out where the record shows that these
are old and well-known elements. Absent such a showing, the
Examiner has not satisfied his burden of proof.

IV. Page 17 of the Answer addresses PARRILLO and
appears to attempt to dispute that PARRILLO does not teach a
user-set password, as claimed.

However, the Answer does not address the points raised in the Appeal Brief, i.e., on pages 9-10.

The Answer does not address that the PARRILLO password is not a user-set password as required by the claims.

The PARRILLO Abstract discloses that the user enters a PIN code <u>in accordance with a prescribed, but variable, sequence,</u> and that the user inputs the PIN by entering a sequence of alphanumeric symbols in accordance with <u>a prescribed "start" sequence of symbols for recognition as a proper 4-digit PIN for a first transaction</u>. PARRILLO teaches that in "the broadest aspect of the invention, the user inputs the PIN by entering a sequence of alphanumeric symbols in accordance with a prescribed 'start' sequence of symbols for recognition as a proper 4-digit PIN for a first transaction". The system, upon recognizing the correct PIN, will give the user access to the account. See PARRILLO column 3, line 68 expressly teaches "At the same time, the system increments at least one of the digits of the stored PIN for that account so that, in effect, the user must enter a new PIN to access the same account on subsequent tries." See also beginning at line 12 of column 4. From these passages, it is clear that the PARRILLO system is in control of setting and remembering the passwords.

PARRILLO is not a user-set password but is a system-set password which the user merely enters.

Summary

In view of Appellant's Appeal Brief and the foregoing Reply, it follows that both grounds of rejections are improper and should be reversed. Accordingly, reversal of the pending obviousness rejections is respectfully solicited.

Respectfully submitted,

YOUNG & THOMPSON

By ___/Roland E. Long, Jr./____
      Roland E. Long, Jr.
      Attorney for Appellant
      Registration No. 41,949
      209 Madison Street
      Suite 500
      Alexandria, VA 22314
      Telephone: 703/521-2297

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